

PATENT
Application # 09/867,803
Attorney Docket # 1005-006

REMARKS

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 2, and 5-8 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry. Support for the amendments to each of claims 1, 2, and 5-8 can be found in the specification as originally submitted at least at pages 22-28 and pages 62-68. It is respectfully submitted that no new matter has been introduced.

Claims 1-8 are now pending in this application. Each of claims 1, 2, and 5-8 is in independent form.

I. The Statutory Subject Matter Rejections

Each of claims 1-8 was rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Applicant respectfully traverses each of these rejections as moot in view of the present amendments to each of claims 1, 2, and 5-8.

Specifically, independent claim 1 from which each of claims 3 and 4 ultimately depends, states, *inter alia*, "one or more of the plurality of clusters usable to manage a marketing strategy". Applicant respectfully submits that managing "a marketing strategy" results in each of claims 1, 3, and 4 being directed toward statutory subject matter.

PATENT
Application # 09/867,803
Attorney Docket # 1005-006

Independent claim 2 states, *inter alia*, "one or more of the plurality of clusters usable to manage a business tactic". Applicant respectfully submits that managing "a business tactic" results in claim 2 being directed toward statutory subject matter.

Independent claim 5 states, *inter alia*, "one or more of the plurality of clusters usable to make a medical diagnosis". Applicant respectfully submits that making "a medical diagnosis" results in claim 5 being directed toward statutory subject matter.

Independent claim 6 states, *inter alia*, "one or more of the plurality of clusters usable to manage a financial strategy". Applicant respectfully submits that managing "a financial strategy" results in claim 6 being directed toward statutory subject matter.

Independent claim 7 states, *inter alia*, "one or more of the plurality of clusters usable to manage a pharmaceutical drug development process". Applicant respectfully submits that managing "a pharmaceutical drug development process" results in claim 7 being directed toward statutory subject matter.

Independent claim 8 states, *inter alia*, "one or more of the plurality of clusters usable to make an economic decision". Applicant respectfully submits that making "an economic decision" results in claim 8 being directed toward statutory subject matter.

For at least these reasons, reconsideration and withdrawal of these rejections is respectfully requested.

II. The Enablement Rejections

Each of claims 1 and 3-6 was rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. These rejections are respectfully traversed.

The rejection states that the "Claims 1, 3-6 contain the limitation 'calculating a percent of proxy values for the plurality of variables that equals a mode of that observation's corresponding cluster's proxy values for the corresponding variables' which was not described in the specification in such a way as to enable one skill in the art to which it pertains, or with which it is most nearly connected, to make and/or use of the invention." See Page 5.

Yet the Office Action fails to establish a *prima facie* case for a rejection based on non-enablement. A *prima facie* case of non-enablement requires that the Office Action provide:

PATENT
Application # 09/867,803
Attorney Docket # 1005-006

1. a rational basis as to:
 - a. why the disclosure does not teach (*see, Fiers v. Sugano*, 984 F.2d 1164, 25 UPSQ2d 1601, 1607 (Fed. Cir. 1993) (*quoting Well v. Fritz*, 601 F.2d 551, 555, 202 USPQ 447, 450 (CCPA 1979)), or
 - b. why to doubt the objective truth of the statements in the disclosure that purport to teach (*see, Fiers v. Sugano*, 984 F.2d 1164, 25 UPSQ2d 1601, 1607 (Fed. Cir. 1993) (*quoting In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (1969)));
2. a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure (*In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993);
 - a. without undue experimentation (*see, In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 219 (1976) (*citing In re Armbruster*, 512 F.2d 676, 185 USPQ 152 (1975));
 - b. and dealing with subject matter that would not already be known to the skilled person as of the filing date of the application (*see, Webster Loom v. Higgins*, 105 U.S. (15 Otto) 580 (1881)).

The need for presenting a *prima facie* non-enablement rejection is explained at MPEP 2164.04 ("it is incumbent on the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." *In re Marzocchi*, 439 F.2d 220,224, 169 USPQ 367, 370 (CCPA 1971) (emphasis in original)).

The present Office Action fails to provide any evidence whatsoever regarding any of the elements required for a *prima facie* non-enablement rejection. Included herewith is a Declaration under 37 C.F.R. § 1.132 of Dr. Bo Honore, one skilled in the art of econometrics as of 31 January 2001, the priority date claimed by the present application. Paragraphs 8-19 of Dr. Honore's Declaration provide evidence that one skilled in the art would have been able to make and use the claimed subject matter of each of claims 1 and 3-6 without undue experimentation.

PATENT
Application # 09/867,803
Attorney Docket # 1005-006

Thus, reconsideration and withdrawal of each of the rejections of each of claims 1 and 3-6 is respectfully requested.

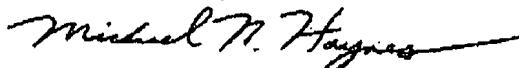
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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